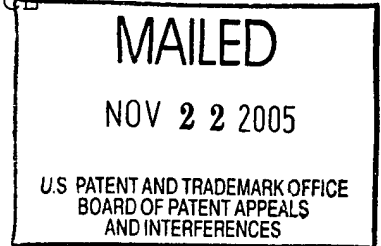


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte STEVEN M. BELZ, SUSANNE CHAMBERS
and KENNETH A. PARULSKI

Appeal No. 2005-2477
Application No. 10/017,809

ON BRIEF

Before OWENS, DIXON, and MACDONALD, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-7 and 9-15, which are all of the pending claims.

THE INVENTION

The appellants claim a system and method for providing communication over a channel between digital cameras and a service provider. Claims 1 and 5, which claim the system, are illustrative:

1. A system including a digital camera and a docking unit to permit the digital camera to be coupled to a channel for communication with a service provider, comprising:

- a) the digital camera including:
 - i) a viewable display;
 - ii) a lens for providing an optical image;

iii) an image sensor for receiving the optical image provided by the lens to produce an image signal, a processor responsive to the image signal for producing a digital image so that the viewable display can respond to such image to provide a viewable image;

iv) a memory for storing a plurality of captured digital images having a first image size, and for storing a plurality of transferred digital images having a second image size, smaller than the first image size;

v) a docking interface to permit the digital camera to be connected to the docking unit; and a processor coupled to the memory for providing communication through the docking unit to a channel so that captured digital images stored in the memory are transferred over the channel to the service provider and transferred digital images are received over the channel from the service provider and stored in the memory, the processor further being couple [sic] to the viewable display so that the captured digital images and the transferred digital images stored in the memory can be viewed on the viewable display; and

b) the docking unit including

i) a connector for receiving the docking interface in the digital camera and for connecting the digital camera to the docking unit;

ii) a power supply for providing power to the digital camera; and

iii) a network connection for interconnecting the docking unit to the channel for transferring captured digital images of the first size to the service provider and for receiving transferred digital images of the second size from the service provider.

5. A system including a plurality of digital cameras, and docking units, and a service provider, to permit the digital camera to be coupled to the Internet, comprising:

a) the digital camera including:

- i) a viewable display;
- ii) an image captured lens;
- iii) an image sensor for receiving a visual image provided by the capture lens to produce an image signal, a processor responsive to the image signal for producing a digital image so that the viewable display can respond to such image to provide a viewable image,
- iv) a docking interface to permit the digital camera to be connected to the docking unit; and
- b) the docking unit including:
 - i) a connector for providing an electrical connection with the docking interface in the digital camera; and
 - ii) a network connection for interconnecting the docking unit to the channel; and
- c) the service provider including a memory for storing a plurality of user accounts, each identifying particular content categories previously select by a particular user, and content information corresponding to the plurality of content categories, and for communicating content information to a plurality of digital cameras associated with the plurality of user accounts, whereby the content information, corresponding to content categories identified in the service account associated with each digital camera, is communicated over the Internet to the plurality of digital cameras; and
- d) the digital camera receiving the content information and displaying the content information on the viewable display.

THE REFERENCES

Safai et al. (Safai)	6,167,469	Dec. 26, 2000
Sato et al. (Sato)	2001/0024236	Sep. 27, 2001
(U.S. patent application publication)		
Tanaka et al. (Tanaka)	6,392,697	May 21, 2002
		(filed Feb. 19, 1998)

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Viktors¹ 2000-232599 Aug. 22, 2000
(Japanese patent application)

Japan Electronic Industry Development Association Standard, *Design Rule for Camera File System, Version 1.0, JEIDA-49-2-1998* (Dec. 1998) (Design Rule).

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1, 3 and 11 over Safai in view of Viktors and Tanaka; claim 2 over Safai in view of Viktors, Tanaka and Sato; claim 4 over Safai in view of Viktors, Tanaka and Design Rule; and claims 5-7, 9, 10 and 12-15 over Safai in view of Sato.²

OPINION

We reverse the aforementioned rejections. Under the provisions of 37 CFR § 41.50(b) we enter a new ground of rejection of claims 1-4 and 11. With respect to the rejections under 35 U.S.C. § 103 we need to address only the independent claims, i.e., claims 1, 5 and 12.³

¹ Our consideration of Viktors is based upon the English translation thereof which is of record.

² The examiner relies upon U.S. 6,812,962 to Fredlund et al. (answer, page 15). That reference is not included in the statement of the rejection and, therefore, is not properly before us. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970). Consequently, we have not considered it.

³ The examiner does not rely upon Sato or Design Rule for any disclosure that remedies the deficiency in Safai, Viktors and

Claim 1

Safai discloses a digital image transporting system having a central processing unit coupled to a hot-pluggable external interface that enables a digital camera to be connected to a docking station such that the digital camera can communicate images over a network to external computing devices such as a server computer that can forward the images to addressees (col. 3, lines 52-58; col. 6, lines 60-65).

Tanaka discloses a housing containing a wireless telephone and a digital still camera (col. 1, lines 39-42). If the digital still camera is capable of receiving and displaying a digital electronic still image signal generated by another digital still camera, then the sending digital still camera reduces the number of pixels per frame from 240,000 to 60,000 and sends the electronic still image signal to the receiving digital still camera (col. 5, lines 9-18 and 30-41).⁴

The examiner argues (answer, pages 5-6):

Tanaka discloses the use of a memory that stores images of two different sizes (column 5, lines 9-11; the camera

Tanaka as to claim 1.

⁴ Viktors is relied upon by the examiner for a suggestion to include a power supply in Safai's docking station (answer, page 5), and there is no dispute as to that issue.

stores the 240,000 pixel image and the 60,000 pixel image) and transferring images of a first size (column 9, lines 48-49) and receiving images of a second smaller size (column 6, line 63 - column 7, line 1). Tanaka teaches that the use of a memory that stores images of two different sizes and transferring images of a first size and receiving images of a second smaller size is preferred in order to transmit the images more quickly due to device compatibility and the reduced image size (column 5, lines 12-13; if the device is capable of receiving a smaller image file, then that image is sent to reduce transmission time). Therefore, it would have been obvious to one of ordinary skill in the art to have been motivated to modify the Safai device to include the use of a memory that stores images of two different sizes and transferring images of a first size and receiving images of a second smaller size as suggested by Tanaka.

The appellants' claim 1 requires that 1) captured digital images stored in the digital camera's memory are transferred over a channel to a service provider, and 2) transferred digital images are received over the channel from the service provider and stored in the memory. Tanaka's 240,000 pixel images and 60,000 pixel images both are sent from a first digital camera to a second digital camera (col. 5, lines 14-18 and 30-41). The examiner does not explain how the applied references would have fairly suggested, to one of ordinary skill in the art, the combination of transferring captured digital images from a digital camera's memory over a channel to a service provider and transferring digital images over the channel from the service provider and storing them in the digital camera's memory.

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The examiner, therefore, has not established a prima facie case of obviousness of the system claimed in the appellants' claim 1. Consequently, we reverse the rejection of that claim and claims 2-4 and 11 that depend therefrom.

Claims 5 and 12

Sato discloses an electronic camera having a communication mode that permits a user to establish communication with a server (§ 0043). The server then transmits available contents information to the electronic camera, and the user selects a desired item by operating an information input device. See *id.* The selection is transmitted to a tourist spot information server that sends the selected information to the electronic camera (§§ 0044, 0055-0056 and 0072-0073).

Claims 5 and 12 require a service provider including a memory for storing a plurality of user accounts, each identifying particular content categories previously selected by a particular user.

The examiner argues (answer, pages 9-10):

Sato discloses the use of a plurality of content categories that are communicated to the camera as selected by the user (page 5, paragraph 0075). Sato teaches that to receive a plurality of content categories that are selected by the user is preferred in order for the user to have access to a plurality of services as often as possible (paragraph 0008, lines 4-5).

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Therefore, it would have been obvious to one of ordinary skill in the art to have been motivated to modify the Safai device to include the receipt of a plurality of content categories as suggested by Sato.

Paragraph 0075 relied upon by the examiner does not disclose user selection of content categories. Instead, it discloses that the pieces of desired information selected by the user from the contents information provided to the user by the tourist spot information server are recorded and may be displayed. Furthermore, paragraph 0008, lines 4-5 does not disclose receipt of a plurality of content categories selected by a user but, rather, discloses that the system allows images or maps of neighboring tourist spots to be easily obtained.

We therefore conclude that the examiner has not established a prima facie case of obviousness of the inventions claimed in the appellants' claims 5 and 12. Accordingly, we reverse the rejection of claim 5 and its dependent claims (6, 7, 9 and 10) and claim 12 and its dependent claims (13-15).

New ground of rejection

Under the provisions of 37 CFR § 41.50(b) we enter the following new ground of rejection.

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Claims 1-4 and 11 are rejected under 35 U.S.C. § 112, first paragraph, as failing to have adequate written descriptive support in the appellants' original specification.

Claim 1 requires that captured digital images of a first size are transferred from a digital camera to a service provider, and digital images of a second size, smaller than the first size, are transferred from the service provider and are stored in the digital camera's memory.⁵

The appellants' original specification discloses that a processor in the digital camera creates and stores larger and smaller digital images, and that the smaller digital image is displayed for the user to review (page 10, line 31 - page 11, line 9). The original specification, however, does not disclose transferring the larger image from the digital camera to a service provider and transferring the smaller image to the digital camera. Thus, claim 1 and claims 2-4 and 11 that depend therefrom lack adequate written descriptive support in the appellants' original specification.

⁵ This claim requirement was added by amendment.

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DECISION

The rejections under 35 U.S.C. § 103 of claims 1, 3 and 11 over Safai in view of Viktors and Tanaka, claim 2 over Safai in view of Viktors, Tanaka and Sato, claim 4 over Safai in view of Viktors, Tanaka and Design Rule, and claims 5-7, 9, 10 and 12-15 over Safai in view of Sato, are reversed. A new ground of rejection of claims 1-4 and 11 has been entered under 37 CFR § 41.50(b).

REVERSED, 37 CFR § 41.50 (b)

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge


 ALLEN R. MACDONALD
 Administrative Patent Judge

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